Remarks

The various parts of the Office Action are discussed below under similar headings.

Election/Restrictions

In view of the requirement for restriction imposed by the Examiner, claims 9-11 have been cancelled.

Specification

The withdrawal of the objection to the disclosure is noted with appreciation.

Claim Objections

The withdrawal of the objection to claim 6 is noted with appreciation.

Claim Rejections - 35 USC § 112

The withdrawal of the rejection of claims 1-7 under 35 U.S.C. 112 is noted with appreciation.

Claim Rejections - 35 USC § 103

Before discussing the prior art rejections, it is noted that several editorial changes have been made in the claims. In addition, claims 5 and 6 have been consolidated into amended claim 5 which has been rewritten in independent form, and claim 6 has been cancelled.

U.S. Patent No. 6,231,670 Is Not Prior Art

Claims 1-8 have been rejected over a combination of references including Fisher et al. U.S. Patent No. 6,231,670. The '670 does not qualify as prior art to the invention herein claimed and therefore the rejection is improper for at least this reason. The Examiner's attention is invited to MPEP Section 901.04 which reads as follows:

> The following different series of U.S. patents are being or in the past have been issued. The date of patenting given on the face of each copy is the publication date and is the one usually cited. The filing date, in most instances also given on the face of the patent, is ordinarily the effective date as a reference (35 U.S.C. 102(e)). See MPEP § 2127, paragraph II.

> The 35 U.S.C. 102(e) date for a nonprovisional application claiming the benefit of a prior provisional application (35 U.S.C. 111(b)) is the filing date of the provisional application. (emphasis added)

and to MPEP Section 2136.03 which reads:

> Reference's Foreign Priority Date Under 35 U.S.C. 119(a)-(d) and (f) Cannot Be Used as the 35 U.S.C. 102(e) Reference Date
>
> A U.S. patent reference is effective prior art as of its U.S. filing date. 35 U.S.C. 119(a)-(d) and (f) does not modify section 102(e) which is explicitly limited to certain references "filed in the United States before the invention thereof by the applicant" (emphasis added). Therefore, the foreign priority date of the reference under 35 U.S.C. 119(a)-(d) and (f) cannot be used to antedate the application filing date. In contrast, applicant may be able to overcome the 35 U.S.C. 102(e) rejection by proving he or she is entitled to his or her own 35 U.S.C. 119 priority date which is earlier than the reference's U.S. filing date. *In re Hilmer*, 359 F.2d 859, 149 USPQ 480 (CCPA 1966) (*Hilmer I*) (Applicant filed an application with a right of priority to a German application. The examiner rejected the claims over a U.S. patent to Habicht based on its Swiss priority date. The U.S. filing date of Habicht was later than the application's German priority date. The court held that the reference's Swiss priority date could not be relied on in a 35 U.S.C. 102(e) rejection. Because the U.S. filing date of Habicht was later than the earliest effective filing date (German priority date) of the application, the rejection was reversed.). See MPEP § 201.15 for information on procedures to be followed in considering applicant"s right of priority. (emphasis added)

The effective date of the '670 patent as a reference is January 14, 2000. The present application has an effective filing date of January 26, 1999. Therefore, the rejection should be withdrawn for at least this reason and the finality of the last Office Action should be withdrawn as well.

The non-prior art status of the '670 patent was indicated in applicant's reply to the last Office Action, but the Examiner continues to reject claims with reliance on the '670 patent without any explanation of why the Examiner continues to believe this reference qualifies as prior art.

Amended Claim 5

Even if the '670 patent qualified as prior art, it is submitted that the claims would otherwise be pat ntable because any fair combination of the references would not yield the applicant's invention as set forth in the claims. For instance, the applied references

do not teach or suggest the method of amended claim 5 wherein the abrasive substance comprises at least one of aluminium oxide and silicon carbide having a mean particle size of 60 to 160 μ-m. The particle size of Hosler U.S. Patent No. 4,505,974[1] is comparatively small, noting in particular the preferred particle size range from about 20 to 60 millimicrons (see claim 6). Further, the particle size disclosed by Michl U.S. Patent No. 3,135,643 ranges to 1 micron (see Example 1). Thus, the skilled person would not be motivated to use as an abrasive material at least one of aluminium oxide and silicon carbide having a mean particle size of 60 to 160 μ-m in the performance of the methods taught by Hosler and Michl. Moreover, no such motivation can arise from Lindgren et al. U.S. Patent No. 5,034,272 as this patent relates to a significantly different process than those disclosed by Hosler and Michl, particularly since any increase in particle size relative to the teachings of Hosler and Michl would result in a deviation from the intended objectives of Hosler and Michl.

Conclusion

Allowance of the application is respectfully requested.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted by facsimile to 703-872-9311 on the date shown below for filing in the United States Patent and Trademark Office.

Date: October 16, 2002

Jennifer A. Moore

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[1] The '974 patent does not appear to have been properly made of record in that it is not listed on a PTO-892 form. Also, a copy of the reference was not supplied with the Office Action.